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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,438	01/23/2004	Andrew M. Hatch	HSTI 0135 PUS1/H50006AHST	6831
35312 7590 12/22/2009 BROOKS KUSHMAN P.C./ HENKEL CORPORATION 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			EXAMINER DOUYON, LORNA M	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/22/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,438	<b>Applicant(s)</b> HATCH ET AL.	
	<b>Examiner</b> Lorna M. Douyon	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,14,16,17,80-86,88,89,91-94 and 96-99 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,14,16,17,80-86,88,89,91-94 and 96-99 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/11/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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1. This action is responsive to the amendment filed on August 24, 2009.
2. Claims 1-4, 6-10, 14, 16-17, 80-86, 88-89, 91-94, 96-99 are pending. Claims 5, 11-13, 15, 18-79, 87, 90, 95 are cancelled. Claims 96-99 are newly added.
3. Claims 1-4, 6-10, 14, 16-17, 80-86, 88-89, 91-94, 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent No. 6,214,777), hereinafter "Li", for the reasons set forth in the previous office action. Please note that Li does not teach perfumes.
4. Claims 1-4, 7-10, 14, 16-17, 80-85, 88-89, 91-94, 96-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yianakopoulos (US Patent No. 5,462,697) for the reasons set forth in the previous office action. With respect to newly added claims 96 and 97, please note that Yianakopoulos does not teach, disclose or suggest quaternary phosphonium compounds, and with respect to the perfume, please note that in place of perfume, a water insoluble hydrocarbon is used (see col. 4, lines 16-17), e.g., a water insoluble paraffin or isoparaffin having about 6 to about 18 carbon (see col. 6, lines 21-24).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 96-97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "free of quaternary phosphonium compounds" in newly added claim 96 and "free of perfume" in newly added claim 97 are not supported in the specification and are considered as new matter. The added limitation in these claims lacks literal basis in the specification as originally filed, see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984).

***Claim Rejections - 35 USC § 102/103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 99 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoshowski et al. (US Patent No. 4,960,588), hereinafter "Hoshowski".

Hoshowski teaches an emulsion/conditioner for hair which comprises 0.3 wt% ethoxylated (23) lauryl alcohol (having 23 moles of ethoxy groups, and which reads on

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component A of the present claims, R=12), 5.7 wt% ethoxylated (4) lauryl alcohol (which reads on component C of the present claims), hydrochloric acid (HC1) to adjust the pH to 2.7-4.5, and the balance water (see Example II, col. 14, lines 36-52). Even though Hoshowski does not teach a cleaning metal article use of his composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Exparte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393. The emulsion/conditioner should inherently possess a water-break-free percent reduction within those recited because same ingredients have been utilized. Hence, Hoshowski anticipates the claim.

9. Claim 99 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Neidiffer et al. (US Patent No. 4,959,105), hereinafter "Neidiffer".

Neidiffer teaches, In Example 1, an aluminum clear composition which comprises 92.5 wt% water, 0.7 wt% sulfuric acid (25% by weight in water), 0.07 wt% Surfactant I (which is a commercially available anionic material including a free acid of a complex organic phosphate ester, 0.07 wt% Surfactant II (which is a commercially available nonionic material including block copolymers of propylene oxide and ethylene oxide (reads on Component C), 0.03 wt% Surfactant III (which is a commercially available nonionic material including ethoxylates of secondary alcohols containing about 11 to about 15 carbon atoms per molecule (reads on Component A), and 0.13 wt% Surfactant IV (which is a commercially available blend of anionic and nonionic surfactants, believed

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to be linear alkyl sulfates together with ethoxylates of secondary alcohols as noted in Surfactant III (see col. 8, lines 10-59). Even though Neidiffer does not explicitly disclose the composition having an average water-break- free percent reduction of less than 50% after 7 days of aging, it would be inherent for the composition of Neidiffer to exhibit the recited property because same ingredients have been utilized. Hence, Neidiffer anticipates the claims.

### ***Response to Arguments***

10. Applicants' arguments filed August 24, 2009 have been fully considered but they are not persuasive.

With respect to the obviousness rejection based upon Li, Applicants argue that Li's composition is used for a different purpose, is used differently, and is used at a totally different phase of the bottling process.

The Examiner respectfully disagrees with the above argument because even though Li does not teach the use of the composition for cleaning formed metal articles, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393.

Applicants also argue that Li discloses a composition having a pH of 3 to about 9.5, while the pH of the cleaning composition in claim 1 is less than 2. Applicants also argue that while the term "about" does provide some tolerance, it is unreasonable to

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assume that such tolerance would allow reading a pH less than 2, which is 10 times more acidic than the pH of 3 of Li.

The Examiner respectfully disagrees with the above argument because in col. 6, lines 44-57, Li teaches that the composition has a pH in the range of about 3 to about 9.5. The Examiner maintains that the word “about” permits some tolerance. (At least about 10% was held to be anticipated by a teaching of a content not to exceed about 8%, see *In re Ayers*, 154 F 2d 182,69 USPQ 109 (CCPA 1946). A pressure limitation of 2-15 pounds per square inch was held to be readable on a reference which taught a pressure of the order of about 15 pounds per square inch, see *In re Erickson*, 343 F 2d 778, 145 USPQ 207 (CCPA 1965). Hence, “less than 2” pH of the present claims reads on the “about 3” pH of Li. In alternative, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner*, 778F.2d 775,227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.051.

Applicants also argue that the composition of Li do not have similar ingredients with those of the present claims because Li is directed at providing a lubricant and includes a quaternary phosphonium compound as its primary ingredient, which ingredient is not found in Applicants' composition.

The Examiner respectfully disagrees with the above argument because “comprising” (of independent claims 1 and 80) leaves the claim open for the inclusion of unspecified ingredients even in major amounts, see *Ex parte Davis et al.*, 80 USPQ 448

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(PTO Ed. App. 1948). Also, the broad “comprising” and “containing” terminology do not exclude the presence of other ingredients in the composition, unlike the narrow “consisting of” language, see *Swain v. Crittendon*, 332 F.2d 820, 14 USPQ 811 (CCPA 1964). In addition, the “consisting essentially of” language (of independent claims 98 and 99) does not necessarily exclude the a quaternary phosphonium compound of Li because “consisting essentially of” renders the composition open to the inclusion of unspecified ingredients which do not materially affect the *basic* and *novel* characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448.

With respect to the obviousness rejection based upon Yianakopoulos, Applicants argue that Yianakopoulos is non-analogous art and teaches cleaning hard surfaces like painted woodwork and panels, tile walls...but not metallic, let alone aluminum or aluminum alloys.

The Examiner respectfully disagrees with the above argument because in col. 3, lines 47-53, Yianakopoulos teaches: *The present invention provides an improved, clear, liquid cleaning composition having improved interfacial tension which improves cleaning hard surface in the form of a microemulsion which is suitable for cleaning hard surfaces such as enamel, plastic, vitreous and metal surfaces having a shiny finish or in the form of an all purpose hard surface cleaning composition* (underlining supplied).

Applicants also argue that Yianakopoulos does not disclose, teach or suggest a cleaning composition comprising an ethoxylate having 12 to 80 carbon atoms and 20 to 80 mole ethoxylate and another surfactant different from the first.



The Examiner respectfully disagrees with the above arguments because Yianakopoulos teaches that the nonionic surfactant includes the condensation products of a higher alcohol (e.g., an alkanol containing about 8 to 18 carbon atoms in a straight or branched chain configuration) condensed with about 5 to 30 moles of ethylene oxide (see col. 8, lines 47-51 ) and also teaches that the acidic all purpose hard surface cleaning composition comprises approximately 0.1% to 30 wt% of at least one surfactant selected from the group consisting of nonionic surfactants and anionic surfactants (see col. 4, lines 43-45, col. 15, lines 64-67). Hence, with this teaching, more than one nonionic surfactants may be used, and may have ethylene oxide units, say for example, 5 moles in one and 30 moles in the other.

With respect to newly added claims 98-99, Applicants argue that these claims are “consisting essentially of” claims and that both Li and Yianakopoulos have components that are not present in these claims, and that the quaternary ammonium phosphonium compounds in Li, and the anti-corrosive agents in Yianakopoulos would change the basic and novel properties of the claimed cleaning composition.

The Examiner respectfully disagrees with the above arguments because the “consisting essentially of” language of independent claims 98 and 99 does not necessarily exclude the a quaternary phosphonium compound of Li, or the anti-corrosive agents of Yianakopoulos because “consisting essentially of” renders the composition open to the inclusion of unspecified ingredients which do not materially affect the *basic* and *novel* characteristics of the composition, see *Ex parte Davis et al.* (Bd of Appeals), 80 USPQ 448. Applicants have not provided evidence that said

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components actually materially affect the *basic* and *novel* characteristics of the composition of the present claims.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/  
Primary Examiner, Art Unit 1796

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